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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,496

01/31/2006

Gilbert Gorr

GRNO-05U1

3542

59538 7590 09/28/2011
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EXAMINER

VOGEL, NANCY TREPTOW

ART UNIT

PAPER NUMBER

1636

MAIL DATE

DELIVERY MODE

09/28/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,496	Applicant(s) GORR, GILBERT	
	Examiner NANCY VOGEL	Art Unit 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1,2,4-8 and 19-29 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☒ Claim(s) 1,2,4-8 and 27 is/are allowed.
- 7) ☒ Claim(s) 19,20,28 and 29 is/are rejected.
- 8) ☒ Claim(s) 21-26 is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/24/11</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1, 2, 4-8, 19-29 are pending.

Receipt of the Information Disclosure Statement on 5/24/11 is acknowledged.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/14/11 has been entered.

Any rejection of record in the previous action not addressed in this office action is withdrawn.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19, 20 and 28 , 29 are rejected under 35 U.S.C. 102(b) as anticipated by Degryse et al. (Yeast 11:629-640, 1995) or Resnick et al. (US Patent 6,391,642) or Bubeck et al. (Nucl. Acids Research, 21 (15);3601, 1993).

Claims 19, 20, 28 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Degryse et al. (Yeast 11:629-640, 1995) or Resnick et al. (US Patent 6,391,642) or Bubeck et al. (Nucl. Acids Research, 21 (15);3601, 1993).

Degryse et al. disclose a set of genetic constructs, wherein the first comprises at least one heterologous nucleotide sequence operably linked to a promoter flanked at the 5' end by a first recombination sequence and at the 3' end by a second recombination sequence, and a second heterologous nucleic acid construct different from the first, comprising at least one heterologous nucleotide sequence operably linked to a promoter, flanked at the 5' end by said second recombination sequence at the 3' end by the first recombination sequence, and said first and second sequence are different, and which recombine in vivo, and which are linear (see Fig. 4).

Resnick et al. disclose a set of genetic constructs, wherein the first comprises at least one heterologous nucleotide sequence operably linked to a promoter flanked at the 5' end by a first recombination sequence and at the 3' end by a second recombination sequence, and a second heterologous nucleic acid construct different from the first, comprising at least one heterologous nucleotide sequence operably linked to a promoter, flanked at the 5' end by said second recombination sequence at the 3' end by the first recombination sequence, and said first and second sequence are different, and which recombine in vivo, and which are linear (see Fig. 13).

Bubeck et al. disclose a set of genetic constructs, wherein the first comprises at least one heterologous nucleotide sequence operably linked to a promoter flanked at

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the 5' end by a first recombination sequence and at the 3' end by a second recombination sequence, and a second heterologous nucleic acid construct different from the first, comprising at least one heterologous nucleotide sequence operably linked to a promoter, flanked at the 5' end by said second recombination sequence at the 3' end by the first recombination sequence, and said first and second sequence are different, and which recombine in vivo, and which are linear.

It cannot be determined by the Examiner, in which orientation the heterologous nucleotide sequences operably linked to a promoter, are with regard to the 5' and 3' recombination sequences, in the references. However, it would have been obvious to have either orientation of said sequences in the two DNA constructs, since it does not affect the disclosure of the references, which disclose the two fragments with 5' and 3' regions of homology.

This is a new rejection not necessitated by applicant's amendment.

Claims 1, 2, 4-8, 27 are allowed.

Claims 21-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY VOGEL whose telephone number is (571)272-0780. The examiner can normally be reached on 7:00 - 3:30, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NANCY VOGEL/
Primary Examiner, Art Unit 1636
NV
9/10/11